

REMARKS

Favorable reconsideration of this application is respectfully requested in view of the claim amendments and following remarks. By virtue of the amendment, claims 1 and 2-27 are pending in the present application of which claims 1, 3 and 13 are independent, claims 25-27 are newly added, and claim 2 is cancelled.

Claim 1 was rejected under 35 U.S.C. § 102(b) as being anticipated by Ma (6,078,407). Claims 2, 3, 9-13 and 19-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bradbury (5,226,540) in view of Bogert (6,062,357) in further view of Ma. Claim 4 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Bradbury, Ma, and Bogert as applied to claim 3 in further view of Bernard (5,675,524) in further view of Lee (5,70,624). Claims 5 and 6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bradbury, Ma, Bogert, Bernard and Lee as applied to claim 4 and further in view of Inagaki et al. (6,504,529). Claims 7 and 14-17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bradbury, Ma, and Bogert as applied to claim 3 and further in view of Kikinis (5,870,624). Claims 8 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bradbury, Ma, and Bogert as applied to claim 3 and further in view of Ma (5,880,928). These rejections are respectfully traversed for at least the reasons set forth below.

Claim Rejection Under 35 U.S.C. §102

The test for determining if a reference anticipates a claim, for purposes of a rejection under 35 U.S.C. § 102, is whether the reference discloses all the elements of the claimed combination, or the mechanical equivalents thereof functioning in substantially the same way

to produce substantially the same results. As noted by the Court of Appeals for the Federal Circuit in *Lindemann Maschinenfabrick GmbH v. American Hoist and Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984), in evaluating the sufficiency of an anticipation rejection under 35 U.S.C. § 102, the Court stated:

Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. Therefore, if the cited reference does not disclose each and every element of the claimed invention, then the cited reference fails to anticipate the claimed invention and, thus, the claimed invention is distinguishable over the cited reference.

Claim 1 was rejected under 35 U.S.C. § 102(b) as being anticipated by Ma (6,078,407). Claim 1 has been amended to include the features of claim 2, and claim 2 has been canceled. Claim 1 recites, “a plurality of personal computer components including a CPU, memory, an input device, and an output device, a printing module, and a video cam.” Ma fails to teach at least the claimed printing module and video cam. Accordingly, claim 1 is believed to be allowable over Ma.

Claim Rejections Under 35 U.S.C. §103

The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. § 103 is set forth in MPEP § 706.02(j):

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed

combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Therefore, if the above-identified criteria are not met, then the cited reference(s) fails to render obvious the claimed invention and, thus, the claimed invention is distinguishable over the cited reference(s).

Claims 2, 3, 9-13 and 19-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bradbury (5,226,540) in view of Bogert (6,062,357) in further view of Ma. Of these claims, claims 3 and 13 are independent.

Claim 2 has been cancelled and the features of claim 2 have been combined with claim 1. Accordingly, the rejection of claim 2 is now discussed with respect to claim 1. The features of claim 2 combined herein with claim 1 include, "a plurality of personal computer components including a CPU, memory, an input device, and an output device, a printing module, and a video cam."

The rejection of claim 2 states the following:

The combination of Bradbury/Ma/Bogert teaches wherein the computer system comprises a plurality of personal computer components including a CPU, memory, an input device, an output device, a printing module, and a video cam (SEE Bradbury column 2, lines 28-51).

Claim 2, which is now combined with claim 1, was dependent on independent claim 1 prior to this amendment. Claim 1 was rejected under 102(b) as being anticipated by Ma. Thus, in order to establish a prima facie case of obvious, the rejection of claim 2 must provide motivation for combining the features of claim 2 allegedly taught by Bradbury in column 2, lines 28-51 with Ma. However, the rejection of claim 2 fails to provide motivation for combining Bradbury with Ma, and thus the rejection of claim 2 is improper. Furthermore, it is unclear why Bogert was combined with Ma and Bradbury to reject claim 2. Bogert fails

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to teach or suggest any of the features of claim 2, and the rejection of claim 2 fails to indicate why Bogert was used in the rejection of claim 2 and fails to provide motivation for combining Bogert with Bradbury and Ma. Accordingly, the rejection of claim 2 must be withdrawn. If this rejection is maintained for claim 1 as amended herein with new motivation or if the rejection is changed, the next office action must be non-final.

Claim 3 was rejected under 103 as being unpatentable over Bradbury in view of Bogert in further view of Ma. Bradbury was used as the primary reference. Motivation was provided for combining Ma with Bradbury and for combining Bogert with Bradbury. However, claim 2 was dependent on claim 1 instead of claim 3, and claim 2 was rejected under 102 as being anticipated by Ma. Thus, the motivations provided in the rejection of claim 3 are not applicable in the rejection of claim 2, because claim 2 was dependent on claim 1 instead of claim 3, and the motivation for combining Bradbury with Ma is inapplicable and improper. For example, the rejection of claim 3 states that Bradbury teaches the features of claim 3 except for the following:

Bradbury does not teach, “ a flat screen display module, disposed on top of the system enclosure and electrically coupled to the computer components and the power supply port inside the system enclosure, to display a personal computer application, the flat screen display being rotatably coupled to the system enclosure allowing the flat screen display to be viewable in an open position and to rest on the top of the system enclosure in a closed position, wherein in the closed position the display substantially covers a portion of the scanning module.” ... However, Ma teaches the above limitations as shown in the rejection of claim 1 above.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Bradbury case to have the above features as taught by Ma because Ma teaches how to combine a portable computer and a scanner into a compact unit convenient for carrying by hand (SEE MA lines 19-41) and since the Bradbury case has limited space this is essential.

The rejection of claim 2 does not need motivation for modifying the Bradbury case to have the above features as allegedly taught by Ma. Instead the rejection of claim 2 must

provide motivation for modifying the computer and scanner arrangement of Ma to include the claimed plurality of personal computer components including a CPU, memory, an input device, and an output device, a printing module, and a video cam as was recited in claim 2 and allegedly taught by Bradbury. This motivation is not provided, and thus a prima facie case of obviousness has not been established.

Furthermore, the motivation for combining Ma with Bradbury in the rejection of claim 3 is improper. The motivation states,

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Bradbury case to have the above features as taught by Ma because Ma teaches how to combine a portable computer and a scanner into a compact unit convenient for carrying by hand (SEE MA lines 19-41) and since the Bradbury case has limited space this is essential.

Bradbury discloses a scanner. The scanner is shown and described in another Bradbury patent, 5,212,628 incorporated by reference in the '540 Bradbury patent and referenced in the rejection. In the '628 patent, Bradbury discloses a handheld scanner 34 stowed in the pockets 5-11 of the cover 2 shown in figure 1. See column 4, lines 15-18. The scanner disclosed in Bradbury is much smaller than the scanner used in Ma for portability. The scanner of Ma would never fit in the carrying case of Bradbury, let alone the pockets of a cover. Furthermore, the portable workstation of Bradbury would become less portable if the size of the carrying case of Bradbury were increased to include the scanner of Ma. In addition, the workstation of Bradbury and the arrangement of Ma were designed to be hand carried. Combining the scanner of Ma in the carrying case of Bradbury would significantly increase the weight of the carrying case, and likely make the carrying case of Bradbury very difficult to carry. Thus, the intended use of the devices of Bradbury and Ma is destroyed by combining Ma with Bradbury, because the portability of the device is reduced and the device

would be difficult to hand carry. Thus, claim 1 as amended herein and dependent claims 19 and 20 are believed to be allowable.

As indicated above, claim 3 was rejected over Bradbury (5,226,540) in view of Bogert (6,062,357) in further view of Ma. This rejection is respectfully traversed for at least the reason that the motivation to combine Ma with Bradbury is improper as stated above. In addition, it would have not been obvious to combine Bogert with Bradbury. The Official Action states,

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Bradbury case to have wheels and a retractable handle as taught by Bogert because Bogert provides the motivation for using the features to improve the Bradbury apparatus.

The Official Action further states the motivation is to “enable the weight of the bags to be carried on the wheels” and the “handle extends to a convenient reach when in use and retracts out of the way when not in use.”

This motivation is improper, especially in light of the Bradbury disclosure. Bradbury discloses a rugged air and water tight case to be used in a hostile environment. See Bradbury (5,226,540), column 1, lines 29-41. This suggests that the case is used in an outdoor environment where the wheels of Bogert would prove useless. Furthermore, a retractable handle would be ill suited in an air and water tight case because it would be difficult, if not impossible, to seal a case having a retractable handle. Thus, the case from the Bradbury disclosure would not function as was intended in light of modifications from the Bogert disclosure. Furthermore, the case of Bradbury is designed for hand-carrying using the handle 12 instead of being carried on wheels so the case of Bradbury can be transported in hostile environments, including wet and sandy environments. See column 1, lines 23-24. The

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wheels of Bogert would be of little or no use for transporting the case in a sandy environment. For at least these reasons claims 3, 9-12 and 21-22 are believed to be allowable.

Independent claim 13 recites features similar to claim 3, and thus claims 13 and 23-24 are believed to be allowable for at least the reasons claim 3 is believed to be allowable.

Claim 4 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Bradbury, Ma, and Bogert as applied to claim 3 in further view of Bernard (5,675,524) in further view of Lee (5,70,624). Claim 4 recites,

The system of claim 3, further comprising a tray disposed at bottom of the system enclosure and an input device stored inside the tray when the input device is not in use, wherein the tray includes a docking station port for communicating with a second computer system.

The rejection of claim 4 combines a docking station of Bernard and a tray of Lee with Bradbury, Ma, and Bogert as applied to claim 3 to teach the claimed invention. Firstly, this rejection is purely a hindsight reconstruction of the claims using only the claims and the Applicant's disclosure as the reason for combining the extraordinary number of references to allegedly teach the claimed invention. Furthermore, it would not have been obvious to combine the docking station of Bernard and the tray of Lee in Bradbury, because there is not sufficient space in the case of Bradbury to house the docking station of Bernard and a tray of Lee. The computer and tray of Lee is not provided as a portable device intended to be hand-carried in a hostile environment and thus cannot be used in Bradbury. Lee discloses a docking station for a PDA. The case shown in the '628 patent of Bradbury also does not include room for a PDA and docking station. Thus, it would not have been obvious to

combine Lee and Bernard with Bradbury, Ma, and Bogert, and claim 4 is believed to be allowable.

Claims 5 and 6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bradbury, Ma, Bogert, Bernard and Lee as applied to claim 4 and further in view of Inagaki et al. (6,504,529). It should be noted that the rejection of dependent claims 5 and 6 combines six different references to create a combination that teaches the claimed invention. This rejection is clearly a hindsight rejection. Furthermore, the case of Bradbury is a portable case. None of the references teach or suggest how all the features of claims 5 and 6 allegedly taught by the six combined references would be arranged to fit into the portable case of Bradbury. Thus, claims 5 and 6 are believed to be allowable.

Claims 7 and 14-17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bradbury, Ma, and Bogert as applied to claim 3 and further in view of Kikinis (5,870,624).

Claim 7 recites,

wherein the system enclosure includes a document feed-in slot and a document exit slot disposed on opposite sides of the system enclosure, respectively, such that the scanning module scans the document fed into the document feed-in slot and outputs the document at the document exit slot.

Claims 14-17 recite input and output port means for scanning and printing. It would not have been obvious to include these features in Bradbury. The '628 Bradbury patent discloses the arrangement of the printer 200 in the printer tray 46 provided in the bottom rear of the case of Bradbury. Bradbury discloses,

As an important advantage of the present invention, computer and printer trays 44 and 46 (best illustrated in figures 5-8) are positioned in spaced parallel alignment with one another at the rear of the body 4 of the carrying case 1. See column 3, lines 62-65.

As shown in figure 6 of the '628 Bradbury patent, the arms 74 would block any slots used to feed in documents or output documents to the printer 200. Thus, it would not have been obvious to include the claimed slots in Bradbury and it would not have been obvious to rearrange the printer and computer in Bradbury because it would destroy the important advantage of the invention of Bradbury. Thus, claims 7 and 14-17 are believed to be allowable.

Claims 8 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bradbury, Ma, and Bogert as applied to claim 3 and further in view of Ma (5,880,928). These claims are believed to be allowable for at least the reasons there corresponding independent claims are believed to be allowable.

Newly Added Claims

Claims 25-27 are newly added. According to an embodiment, a movement system, such as a stepper motor and a belt system may be used to move a scanning head for the scanner and for moving paper through a document feed path for the printer. See pages 11 and 12 of the Applicant's disclosure.

Claim 25 recites,

wherein the scanning module and the printing module use one movement system operable to move a scan head for the scanning module and operable to move paper through a document feed path for the printing module.

Claims 26 and 27 recite similar features. None of these features are taught or suggested by the prior art and thus claims 25-27 are believed to be allowable.

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Conclusion

In light of the foregoing, withdrawal of the rejections of record and allowance of this application are earnestly solicited.

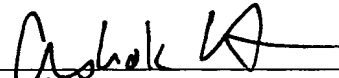
Should the Examiner believe that a telephone conference with the undersigned would assist in resolving any issues pertaining to the allowability of the above-identified application, please contact the undersigned at the telephone number listed below. Please grant any required extensions of time and charge any fees due in connection with this request to deposit account no. 08-2025.

Respectfully submitted,

Cuc Hong

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